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09/905,356	07/13/2001	Yuichiro Deguchi	SONI-6300	3812
7590	03/30/2004		EXAMINER	
Valley Oak Law Number 106 5655 Silver Creek Valley Road San Jose, CA 95138			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,356

Applicant(s)

DEGUCHI, YUICHIRO

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Response to Amendment

This is in response to an amendment file on February 27th, 2004 for letter for patent application filed on July 13th, 2001 in which claims 1-47 were presented for examination. In the amendment, claims 1, 11, 21, 33, 40 and 47 have been amended, no claim has been canceled, and no claim has been added. Claims 1-47 remain pending in the letter.

Response to Arguments

1. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 40 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply,

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involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 40 only recites an abstract idea. The recited method of purchasing a data marking device from a vendor, marking one or more broadcast data etc. do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 40 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Rhoads et al (U.S. PG Pub. No 2002/0012403) in view of Pocock (U.S. PG Pub. 2002/0023272).

7. As per claims 1, Rhoads et al teach vendor tracking system for use with a data marking device, comprising: a data network (*network fig 1*) a user terminal (*user device, 10*) coupled to the data network configured to transmit a signal including information corresponding to marked data (*see figs 4, 5*) a vendor terminal (*server, local application*) configured to transmit (*extract and communicate*) a vendor identification code (*code identifier to identifies distributor*) (*see figs 7-9, paragraphs 0118-0123*); a server terminal coupled to the data network configured to receive the signal from the user terminal and the vendor identification code, the server terminal further configured to transmit information corresponding to the vendor identification code and the received signal to the user terminal (*see figs 7-9, paragraphs 0118-0123*). Rhoads et al fail to teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time. However, Pocock et al teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time (*see paragraph 0019, 0044*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al's inventive concept to include Pocock's inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time because this would have provided the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase.

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8. As per claims 2, Rhoads et al teach vendor tracking system wherein the signal corresponding to the marked data includes one or more of a time information a date information, and a user identification information (*see figs 7-9, paragraphs 0118-0123*).

9. As per claims 3, Rhoads et al teach vendor tracking system further including a data marking device configured to transmit information corresponding to the marked data and data marking device identification code (*see figs 7-9, paragraphs 0118-0123*).

10. As per claims 4, Rhoads et al teach vendor tracking system wherein the data marking device identification code is a predetermined length numeric sequence, a predetermined length letter sequence, and a predetermined length combination of numeric and letter sequence (*see figs 7-9, paragraphs 0118-0123*).

11. As per claims 5, Rhoads et al teach vendor tracking system wherein the marked data corresponds to one of a radio broadcast music clip, a television broadcast music clip, and a web-cast broadcast music clip (*see paragraphs 0020-0039*).

12. As per claims 6, Rhoads et al teach vendor tracking system wherein the data marking device includes an electronic music marker (*see paragraphs 0020-0039*).

13. As per claims 7, Rhoads et al teach vendor tracking system wherein the user terminal includes one of a personal computer, an internet access enabled personal digital assistant, a

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Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (*see figs 1, 2, 3*).

14. As per claims 8, Rhoads et al teach vendor tracking system wherein the data network includes one of a Local Area Network (LAN), a Wide Area Network (WAN), and an internet connection (*see paragraphs 0020-0039*).

15. As per claims 9, Rhoads et al teach vendor tracking system wherein the user terminal and the server terminal are coupled to the data network using one of a TCP/IP protocol and a wireless application protocol (*see paragraphs 0020-0039*).

16. As per claims 10, Rhoads et al teach vendor tracking system wherein the vendor terminal is coupled to the data network (*see figs 1, 2, 3*).

17. As per claims 11, Rhoads et al teach vendor tracking system wherein the user terminal includes an output unit, the output unit configured to display information received from the server terminal (*see paragraphs 0020-0039*).

18. As per claims 12, Rhoads et al teach vendor tracking system wherein the displayed information includes a vendor sales information corresponding to the purchase of a product for the marked data from a store related to the vendor terminal (*see paragraphs 0020-0039*).

19. As per claims 13, Rhoads et al teach vendor tracking system wherein the store includes one of a retail store of the vendor terminal and an online store of the vendor terminal (*see paragraphs 0020-0039*).

20. As per claims 14, Rhoads et al teach vendor tracking system wherein the vendor sales information displayed on the display unit of the user terminal includes a telephone number of the store, a hypertext link for the store, a facsimile number of the store, an email address of the store, a price information for the purchase of the product, and a delivery information for the delivery of the product (*see paragraphs 0020-0039*).

21. As per claims 15, Rhoads et al teach vendor tracking system wherein marked data includes information corresponding to a broadcast music clip, and further, wherein the product includes one or more of a CD, a video tape, an audio cassette corresponding to the broadcast music clip (*see paragraphs 0020-0039*).

22. As per claims 16, Rhoads et al teach vendor tracking system wherein the server terminal includes a storage unit for storing the vendor identification code received from the vendor terminal and the received signal from the user terminal (*see paragraphs 0020-0039*).

23. As per claims 17, Rhoads et al teach vendor tracking system wherein the vendor terminal is further configured to transmit one or more of a purchased product identification code, the one

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or more of the purchased product identification code corresponding to the transmitted signal from the user terminal (*see paragraphs 0020-0039*).

24. As per claims 18, Rhoads et al teach vendor tracking system wherein each of the one or more of the purchased product identification code is unique (*see figs 7-9, paragraphs 0118-0123*).

25. As per claims 19, Rhoads et al teach vendor tracking system further including a playlist provider configured to transmit to the server terminal information related to the data broadcast from a radio or a television station corresponding to marked data (*see figs 7-9, paragraphs 0118-0123*).

26. As per claims 20, Rhoads et al teach vendor tracking system wherein the playlist provider is coupled to the data network (*see figs 1, 2, 3*).

27. As per claims 21, Rhoads et al teach vendor tracking system for use with a music marker device (*see figs 4, 5*), comprising: a data network (*network fig 1*); a music marker device (*embedded process, (see figs 1, 2, 3)* configured to store information corresponding to one or more of a music broadcast, a user terminal (*user device, 10*) coupled to the marker device, the user terminal configured to receive the stored information corresponding to the one or more of a music broadcast from the marker device and an identification code corresponding to the marker device for transmission over the data network (*see figs 1, 2, 3*) a vendor terminal (*distributor*)

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configured to transmit a vendor identification code (*distributor ID*) and one or more of purchased marker device identification codes corresponding to the vendor identification code (*see paragraphs 0020-0039*); a server terminal (*server*) coupled to the data network configured to receive the information corresponding to the one or more of the music broadcast and the marker device identification code from the user terminal (*see figs 4, 5*), and the vendor identification code and the one or more the purchased marker device identification codes corresponding to the vendor identification code, the server terminal further configured to compare the identification code received from the user terminal with the one or more of the identification codes received from the vendor terminal, and accordingly, to transmit information to the user terminal based on the comparison (*see figs 7-9, paragraphs 0118-0123*). Rhoads et al fail to teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time. However, Pocock et al teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time (*see paragraph 0019, 0044*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al's inventive concept to include Pocock's inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time because this would have provided the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase.

28. As per claims 22, Rhoads et al teach vendor tracking system wherein the stored information corresponding to the one or more broadcast music includes one or more of a time

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information corresponding to the music broadcast a date information corresponding to the music broadcast and a geographic information corresponding to the music broadcast (*see figs 1, 2, 3*).

29. As per claims 23, Rhoads et al teach vendor tracking system wherein each of the one or more of the purchased marker device identification codes is a unique predetermined length numeric sequence, a unique predetermined length letter sequence, and a unique predetermined length combination of numeric and letter sequence (*see paragraphs 0020-0039*).

30. As per claims 24, Rhoads et al teach vendor tracking system wherein the information transmitted from the server terminal to the user terminal includes one or more of a name of the broadcast music, a name of the artist of the broadcast music, a name of the music album (*see paragraphs 0020-0039*).

31. As per claims 25, Rhoads et al teach vendor tracking system wherein the information transmitted from the server terminal to the user terminal further includes purchase information for the purchase of the broadcast music (*see paragraphs 0020-0039*).

32. As per claims 26, Rhoads et al teach vendor tracking system wherein the purchase information includes information corresponding to a store of the vendor terminal (*see paragraphs 0020-0039*).

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33. As per claims 27, Rhoads et al teach vendor tracking system wherein the information corresponding to the store includes a hypertext link to an online retail store of the vendor terminal.

34. As per claims 28, Rhoads et al teach vendor tracking system wherein the purchase information includes one or more of cost information for the purchase the broadcast music album, shipping information for the delivery of the broadcast music album purchase, and a payment type information for the purchase of the broadcast music album purchase (*see figs 7-9, paragraphs 0118-0123*).

35. As per claims 29, Rhoads et al teach vendor tracking system wherein the information transmitted from the server terminal to the user terminal is displayed on a display unit of the user terminal as one or more of a two-dimensional image, a three-dimensional still image, a dynamic video image, and a text data (*see figs 7-9, paragraphs 0118-0123*).

36. As per claims 30, Rhoads et al teach vendor tracking system wherein the user terminal includes one of a personal computer, an internet access enabled personal digital assistant, a Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (*see paragraphs 0020-0039*).

37. As per claims 31, Rhoads et al teach vendor tracking system wherein the data network includes one of a Local Area Network (LAN), a Wide Area Network (WAN), an internet connection, and a wireless data exchange network (*see paragraphs 0020-0039*).

38. As per claims 32, Rhoads et al teach vendor tracking system wherein the user terminal and the server terminal are coupled to the data network using one of a TCP/IP protocol, and a wireless application protocol (*see paragraphs 0020-0039*).

39. As per claims 33, Rhoads et al teach a method comprising receiving a vendor identification code and one or more data marking device identification code corresponding to the vendor identification code; receiving one or more marked data and a corresponding data marking device identification code; comparing the data marking device identification code corresponding to the vendor identification code with the data marking device identification code corresponding to the one or more marked data; and transmitting purchase information related to the marked data from a vendor corresponding to the received vendor identification code based on the comparing step (*see figs 7-9, paragraphs 0020-0039, 0118-0123*). Rhoads et al fail to teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time. However, Pocock et al teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time (*see paragraph 0019, 0044*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al's inventive concept to include Pocock's inventive concept wherein the marked data indicates a time and the marked data

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represents content that is broadcasted at the time because this would have provided the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase.

40. As per claims 34, Rhoads et al teach a method further including displaying the transmitted purchase information (*see paragraphs 0020-0039*).

41. As per claims 35, Rhoads et al teach a method further including storing the received vendor identification code and the data marking device identification code corresponding to the vendor identification code (*see paragraphs 0020-0039*).

42. As per claims 36, Rhoads et al teach a method further including storing the received one or more marked data and the corresponding data marking device identification code (*see paragraphs 0020-0039*).

43. As per claims 37, Rhoads et al teach a method further including updating the stored one or more data marking device identification code corresponding to the received vendor identification code and the stored data marking device identification code corresponding to the received marked data (*see figs 7-9, paragraphs 0118-0123*).

44. As per claims 38, Rhoads et al teach a method wherein each of the one or more data marking device identification code is unique (*see paragraphs 0020-0039*).

45. As per claims 39, Rhoads et al teach a method wherein the data marking device identification code corresponding to the vendor identification code and the data marking device identification code corresponding to the marked data are the same (*see paragraphs 0020-0039*).

46. As per claims 40, Rhoads et al teach a method comprising purchasing a data marking device from a vendor; marking one or more broadcast data (*embedding process, figs 1, 2*) communicating (*linking*) with a data marking device service provider (*distributor*) (*see fig 2*); receiving purchase information (*offer link sale*) corresponding to the marked one or more broadcast data for purchase from the vendor (*see fig 2*) (*see paragraphs 0020-0039*). Rhoads et al fail to teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time. However, Pocock et al teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time (*see paragraph 0019, 0044*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al's inventive concept to include Pocock's inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time because this would have provided the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase.

47. As per claims 41, Rhoads et al teach a method wherein the data marking device includes an electronic music marker device (*see paragraphs 0020-0039*).

48. As per claims 42, Rhoads et al teach a method wherein the one or more broadcast data includes one or more radio broadcast music clip, a television broadcast music clip and a web-cast broadcast music clip (*see paragraphs 0020-0039*).

49. As per claims 43, Rhoads et al teach a method wherein the communicating includes: connecting to a gateway device; and accessing a user account in a web domain of the service provider (*see paragraphs 0020-0039*).

50. As per claims 44, Rhoads et al teach a method wherein the gateway device includes one or more of a personal computer, an internet access enabled personal digital assistant, a Wireless Application Protocol enabled mobile telephone, and an i-mode enabled mobile telephone (*see paragraphs 0020-0039*).

51. As per claims 45, Rhoads et al teach a method wherein the received purchase information includes a purchase price of a music album corresponding to the marked broadcast data from the vendor (*see paragraphs 0020-0039*).

52. As per claims 46, Rhoads et al teach a method wherein the communicating includes establishing a connection with a data network under one of a TCP/IP protocol, and a wireless application protocol (*see paragraphs 0020-0039*).

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53. As per claims 47, Rhoads et al teach a vendor tracking system for use with a data marking device, comprising: means for receiving a vendor identification code and one or more data marking device identification code corresponding to the vendor identification code; means for receiving one or more marked data and a corresponding data marking device identification code; means for comparing the data marking device identification code corresponding to the vendor identification code with the data marking device identification code corresponding to the one or more marked data; and means for transmitting purchase information related to the marked data from a vendor corresponding to the received vendor identification code based on the comparing means (*see figs 7-9, paragraphs 0020-0039, 0118-0123*). Rhoads et al fail to teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time. However, Pocock et al teach an inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time (*see paragraph 0019, 0044*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rhoads et al's inventive concept to include Pocock's inventive concept wherein the marked data indicates a time and the marked data represents content that is broadcasted at the time because this would have provided the consumer with a timely method to purchase a musical product by supplying all of the required information to conveniently make a music product purchase.

54. Furthermore, the amendment made to claim 40 is not sufficient to overcome the 101 rejection, since no technology is involved in order to produce a concrete result.

Conclusion

55. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

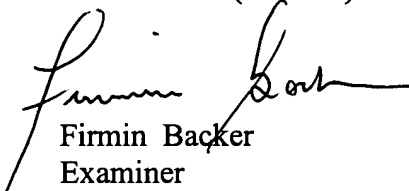
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Examiner
Art Unit 3621

March 25, 2004